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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/576,800	05/23/2000	David W. Cannell	05725.0572	2688

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EXAMINER

FLOOD, MICHELE C

ART UNIT	PAPER NUMBER
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1654

DATE MAILED: 06/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/576,800

Applicant(s)

CANNELL ET AL.

Examiner

Michele C. Flood

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments filed on March 19, 2004 have been fully considered but they are not persuasive.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

Claims 1-13 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The rejection stands for the reasons set forth in the previous Office action and for the reasons set forth in the previous Office action.

Applicant argues that "extract" has a well known meaning in the art by pointing to the definition of the term as defined by the CFTA, which does not define extracts as a product-by-process. However, Applicant's argument is not persuasive because the metes and bounds of a claim are rendered uncertain by the recitation of the term "extract". For instance, a plant extract can be interpreted as ingredients or compositions comprising juices, waters, distillates, powders, oils, waxes, gels, saps, tars, gums, unsaponifiables, and resins. Thus, for the reasons clearly set forth in the previous Office action with regard to the term "extract", the rejection remains the same.

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All other cited claims depend directly or indirectly from rejected claims and are, therefore, also, rejected under U.S.C. 112, second paragraph for the reasons set forth above.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-3, 7 and 10-13 stands rejected under 35 U.S.C. 102(a) as being anticipated by Fath et al. (N; and, Translation of foreign patent document provided herein, U), as evidenced by the teachings of Blum et al. (A), Singh et al. (B) and Hikima et al. (O). Please note that the teachings of Blum, Singh and Hikima are relied upon to set forth the record that wheat germ oil is known in the art as plant extract.

The rejection stands for the reasons set forth in the previous Office action and for the reasons set forth in the previous Office action.

Applicant argues that the wheat germ oil disclosed by Fath is not necessarily an extract, since an oil can be obtained as the result of a non-extraction process, such as cold pressing. Applicant further argues that Fath does not expressly teach that the disclosed wheat germ oil is necessarily an extract. However, Applicant's arguments are not persuasive because the art recognizes wheat germ oil and other plant oils plant extracts whether the plant oils are obtained by solvent extraction or cold pressing

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extraction, as evidenced by the teachings of Blum, Singh and Hikima. Therefore, Fath clearly anticipates the instantly claimed invention because Fath teaches a hair treatment composition green tea extract (a plant extract comprising 1.31% of the total composition), wheat germ oil (a plant extract comprising 0.5% of the total composition), and sucrose (a monosaccharide comprising 1.31% of the total composition), which has the intended purpose for applying to hair. Fath further teaches that the referenced hair treatment composition comprises mono- and-or oligosaccharides. Fath does not expressly teach that the composition can be used in the manner instantly claimed. However, Fath does teach that the referenced composition improves wet and dry combability, luster, feel, and style retention when applied to hair. Thus, a method of protecting keratinous fiber from extrinsic damage is inherent to the use of the composition taught by Fath, given that the referenced composition comprises the instantly claimed ingredients of at least one plant extract of wheat germ, *i.e.*, wheat germ oil, and at least one of the instantly claimed monosaccharides, *i.e.*, sucrose, and given that Applicant readily admits on page 10 of the present application, lines 9-17, "The combability test (See Garcia, M.L., and Diaz, J., J. Soc. Cosmet. Chem. 27, 370-398 (1976)), is known in the art to correlate well to the amount of protection from exposure to extrinsic conditions that is afforded by hair by a composition."

The reference anticipates the claimed subject matter.

Claim Rejections - 35 USC § 103

Claims 1-7 and 10-13 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Fath et al. (N, Translation of foreign patent literature provided herein) in view of Pineau et al. (A). The rejection stands for the reasons set forth in the previous office action and set forth below.

Applicant's arguments have been fully considered but they are not deemed persuasive because the cited references provide the suggestions and motivation to the claimed invention.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the primary reference of teachings of Fath were relied upon for the reasons set forth in the previous Office action and for the reasons set forth above. Because Fath teaches the claimed invention except for the claimed monosaccharides, the secondary reference of Pineau was relied upon because Pineau teaches that the claimed ingredients were effective in the making of therapeutic compositions having the claimed functional effect for the protection of keratinous fibers from extrinsic damage. For instance, Pineau teaches a composition comprising heterogenous polyholosides comprising 2 to 10 uses or

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monosaccharides. Pineau teaches the sugar containing compositions as active agents to combat extrinsic aging of the skin and hair. See Column 3, lines 43-67 to Column 4, lines 1-64.

Thus, with Fath providing the motivation to use a composition comprising wheat germ extract, namely wheat germ oil, in combination with at least one sugar, *i.e.*, one mono- and/or oligosaccharide in the making of a hair treatment product to improve the characteristics of hair; and, with Pineau providing polyholoside-containing compositions having the beneficial functional effect to from extrinsic damage, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the instantly claimed old and well-known ingredients to provide a composition for the use as a composition in a method to protect keratinous fiber from extrinsic damage. As each of the references clearly indicate that the various proportions and amounts of the ingredients used in the claimed composition are result variables, they would have been routinely optimized by one of ordinary skill in the art practicing the invention disclosed by the reference. Thus, the claimed invention is no more than the combining of well known methods for the application of well known ingredients which are known in the art for their beneficial effect of protecting keratinous fiber from extrinsic damage to provide an additive effect, as evidenced by the teachings of Fath and Pineau. Therefore, the invention as a whole was clearly *prima facie* in the absence of evidence to the contrary.

No claims are allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele C. Flood whose telephone number is (571) 272-0964. The examiner can normally be reached on 7:00 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on (571) 272-0961. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MCF
May 27, 2004



CHRISTOPHER R. TATE
PRIMARY EXAMINER